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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,640	01/12/2000	DAVID ELLIOTT WHITTEN	HEM-98/644(H	5923

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EXAMINER	
DEXTER, CLARK F	

ART UNIT	PAPER NUMBER
3724	

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	09/481,640	WHITTEN ET AL.	
	Examiner	Art Unit	
	Clark F. Dexter	3724	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Clark F. Dexter
Primary Examiner
Art Unit: 3724

ATTACHMENT TO ADVISORY ACTION (Paper No. 19)

Response to Arguments

Applicant's arguments filed March 8, 2006 have been fully considered but they are not persuasive.

Under section I at the top of page 5 of the response, applicant argues that

> "JP '670 does not teach or suggest a transfer cylinder cooperating with a rotary cutter."

However, the Examiner does not agree or disagree with this statement, and the Examiner respectfully submits that it was never suggested in the Office action that JP '670 teaches or suggests a transfer cylinder. Rather, the prior art rejections have been made on the basis that given the apparatus of Halliwell (claims 1, 5 and 9) and Neal (claim 11), it would have been obvious to modify each of those apparatus by providing a dancer roll as taught by JP '670 for the reasons taught and/or suggested by the prior art. The Examiner respectfully maintains that such dancer rolls are old and well known in the art and are relatively common. JP '670 merely teaches one example of the use of such a dancer roll in an analogous environment.

Under section II on page 6 of the response, applicant argues that

> "The dancer roller of JP '670 does not compensate for variations in length of a ribbon."

The Examiner respectfully disagrees with applicant's statement, primarily since it is the primary function of a dancer roller to compensate for variations in length of a

workpiece, particularly a web or strand-type workpiece; that is, the primary function of the dancer roller is to maintain a workpiece such that it is taut in an environment where there are variations in length of the workpiece. These variations can be due to various known reasons including mismatches between the speed at which the workpiece is fed to the cutting apparatus versus the speed at which the workpiece is moved through the cutting apparatus. The Examiner respectfully submits that it would have been obvious to one having ordinary skill in the art to provide a dancer roll such as that taught by JP '670 on the apparatus of Halliwell (claims 1, 5 and 9) and Neal (claim 11) for the reasons suggested in the prior art. Further, it is respectfully submitted that the functional recitation "for compensating for variations in length of the ribbon" does not clearly imply any additional structure that is not taught and/or suggested by the prior art. In other words, it is not clear as to what specific structure is not taught or suggested by the applied prior art such that the claimed invention distinguishes over the prior art. Further, it is noted that it is well settled patent law that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

Under section III on page 6 of the response, applicant argues that

> "Neither Neal nor Halliwell adjust a diameter portion in a circumferential region of a transfer cylinder for adjusting a desired cutoff length of signatures."

The Examiner respectfully disagrees with applicant's analysis. The Examiner's position is not that the prior art is used in the same manner as the present invention. Rather, the Examiner's position is that the prior art teaches and/or suggests all of the structure of the claimed invention. The applied prior art clearly discloses (as acknowledged by applicant) structure that adjusts of the circumference of the transfer cylinder. The fact that it is adjusted for a different reason cannot be considered to distinguish the claimed invention over the prior art since the structure of the present invention to the extent claimed is met by the prior art. Further, the functional recitation "for adjusting a desired cutoff length of signatures" does not clearly imply any additional structure that is not taught and/or suggested by the prior art. In other words, it is not clear as to what specific structure is not taught or suggested by the applied prior art such that the claimed invention distinguishes over the prior art. Further, it is again noted that it is well settled patent law that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

It is respectfully submitted that the applied prior art teaches and/or suggests all of the claimed structure and thus the prior art rejections must be maintained.

cfd
March 23, 2006